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10/553,351

09/13/2006

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EXAMINER

DONADO, FRANK E

ART UNIT

PAPER NUMBER

2617

NOTIFICATION DATE

DELIVERY MODE

09/08/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/553,351 | <b>Applicant(s)</b><br>SAKAMOTO, KENJI |  |
|                              | <b>Examiner</b><br>FRANK DONADO      | <b>Art Unit</b><br>2617                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09/13/06.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/14/2005, 01/17/2006, 01/03/2007, 04/16/2008,</u>           | 6) <input type="checkbox"/> Other: _____                          |
| <u>and 05/23/2008.</u>   |   |



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## DETAILED ACTION

### *Claim Objections*

1. Claims 5 and 14 are objected to because of the following informalities:  
**"Encoding"** should be changed to **"encrypting"**, and **"decoding" should be changed to "decrypting"**. In claim 5 only, **"algorisms"** should be changed to **"algorithms"**. Appropriate correction is required.
  
2. Claims 6 and 16 are objected to because of the following informalities: **"Dada"** should be changed to **"data"**. In claim 6 only, **"ODS"** should be changed to **"OSD"**. Appropriate correction is required.
  
3. Claim 15 is objected to because of the following informalities: **"Algorisms"** should be changed to **"algorithms"**. Appropriate correction is required.
  
4. Claims 17-18 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

### *Claim Rejections - 35 USC § 101*

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 9, 19, and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claims 9, 19, and 21, claims the non-statutory subject matter of a control program. Data structures not claimed as embodied in a computer readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1754 (claim to a data structure per se held nonstatutory). Therefore, since the claimed programs are not tangibly embodied in a physical medium and encoded on a computer readable medium then the Applicants has not complied with 35 U.S.C 101.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3, 6-13 and 16-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Shintai, et al (**US PG Publication 2003/0022674**). From now on, Shintai, et al, will be referred to as Shintai.

Regarding claim 1, Shintai teaches a wireless terminal for establishing

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connection with a base device, comprising: connection establishing means for establishing the connection with the base device by obtaining identification data that specifies the base device **(Paragraph 9)**; and connection counterpart notifying means for notifying, based on the identification data, a user of the base device to which the wireless terminal is currently connected **(Paragraph 23, lines 1-5)**.

Regarding claim 2, Shintai teaches a wireless terminal as set forth in claim 1, comprising: connection requesting means for transmitting a connection request command that requests for connection with a base device **(User requests for cell phone's location to be determined as part of a connection process with the base station, Column 23, lines 1-6)**, the connection establishing means for obtaining identification data that reaches the connection establishing means earlier than rest of pieces of identification data that the connection establishing means receives from base devices that respond to the connection request command, and then establishing connection with the base device that is indicated by the thus obtained identification data **(Connection with the base station must be established before any other process may occur. For example, location identification is a secondary means of identification that the connection establishing means receives from the base stations, and this comes only after the base station identifies itself, Paragraphs 23-25 and Figure 3)**.

Regarding claim 3, Shintai teaches a wireless terminal as set forth in claim 2, comprising: connection notifying means for transmitting, after the obtaining of the identification data, a connection process completion command that indicates that the connection with the base device is established **(The completion command is the**

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**location command that occurs after the base id is established, Paragraph 24, lines 1-7).**

Regarding claims 6 and 16, Shintai teaches a wireless terminal as set forth in claim 1 and 11, respectively, comprising: image output means for causing display means to display an image based on image data received from the base device to which the wireless terminal is connected, the connection counterpart notifying means displaying the identification data on the display section in an OSD manner **(Paragraph 25, lines 4-8).**

Regarding claim 7, Shintai teaches a base device comprising: identification data transmission means for transmitting the identification data to the wireless terminal as set forth in claim 1 **(Paragraph 23, lines 1-5).**

Regarding claim 8, Shintai teaches a wireless system comprising: the wireless terminal as set forth in claim 1 **(See Claim 1)**; and a base device comprising identification data transmission means for transmitting the identification data to the wireless terminal as set forth in claim 1 **(Paragraph 23, lines 1-5).**

Regarding claims 9, Shintai teaches a control program for operating a wireless terminal as set forth in claim 1, the control program causing a computer to function as each of the means **(Paragraph 57).**

Regarding claims 10, 20 and 22, Shintai teaches a computer readable storage medium in which the control program as set forth in claims 9, 19 and 21, respectively, is stored **(Paragraph 57).**

Regarding claim 11, Shintai teaches a wireless system comprising a base device and a wireless terminal, wherein: the wireless terminal comprises: connection

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establishing means for establishing the connection with the base device by obtaining identification data that specifies the base device **(Paragraph 23)**; first connection confirming mode transiting means for causing transition into a connection confirmation mode in accordance with input of an instruction from a user **(The dormant mode and the standby mode are employed for receiving the base station id's before a locationing server confirms the base station id's have been received by commencing a positioning function, Paragraph 23, lines 1-7, Paragraph 24, lines 1-7, Paragraph 26, lines 1-6 and Figure 3)**; connection confirming means for obtaining, after the transition to the connection confirmation mode, a connection confirmation command from the base device to which the wireless terminal is connected, the connection confirmation command being for confirming the connection **(A locationing server confirms the base station id's have been received by commencing a positioning function, Paragraph 24, lines 1-7)**; and warning means for warning the user if the connection confirmation means does not obtain the connection confirmation command within a predetermined time after the transition to the connection confirmation mode **(A timer is used to check whether or not a communication with the base station has been established within a prescribed time after the positioning command has been received, Column 31, lines 1-9)**, and the base device comprises: identification data transmission means for transmitting the identification data that identifies the base device **(Paragraph 23, lines 1-5)**; second connection confirming mode transiting means for causing transition into the connection confirmation mode in accordance with the input of the instruction from the user; and connection confirmation command transmitting means for transmitting the



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connection confirmation command, if the transition into the connection confirmation is performed **(The same process described above may be performed using either a dormant or standby mode during which base station id's are received, Column 26, lines 1-6).**

Regarding claim 12, Shintai teaches a wireless system as set forth in claim 11, wherein: the wireless terminal comprises connection requesting means for transmitting a connection request command that requests for connection with a base device, the base device comprises identification data transmission means for transmitting the identification data to the wireless terminal if the base device receives the connection request signal **(User requests for cell phone's location to be determined as part of a connection process with the base station, where the base station id's are determined, including that of the optimum base station, Column 23, lines 1-6),** and the connection establishing means obtains identification data that reaches the connection establishing means earlier than rest of pieces of identification data that the connection establishing means receives from base devices that respond to the connection request command, and then establishes connection with the base device that is indicated by the thus obtained identification data **(Connection with the base station must be established before any other process may occur. For example, location identification is a secondary means of identification that the connection establishing means receives from the base stations, and this comes only after the base station identifies itself, Paragraphs 23-25 and Figure 3).**

Regarding claim 13, Shintai teaches a wireless system as set forth in claim 12, wherein: the wireless terminal comprises connection notifying means for transmitting,

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after the obtaining of the identification data, a connection process completion command that indicates that the connection with the base device is established (**The completion command is the location command that occurs after the base id is established, Paragraph 24, lines 1-7**), and the base device comprises connection acknowledging means for acknowledging the connection with the wireless terminal if the base device receives the connection completion command (**A timer is used to check whether or not a communication with the base station has been established within a prescribed time after the positioning command has been received, Column 31, lines 1-9**).

Regarding claim 17, Shintai teaches a wireless terminal that constitutes the wireless system as set forth in claim 11 (**See claim 11**).

Regarding claim 18, Shintai teaches a base device that constitutes the wireless system as set forth in claim 11 (**See claim 11**).

Regarding claim 19, Shintai teaches a control program for operating a wireless terminal constituting the wireless system as set forth in claim 11, the control program causing a computer to function as each of the means (**Paragraph 57**).

Regarding claim 21, Shintai teaches a control program for operating a base device constituting the wireless system as set forth in claim 11, the control program causing a computer to function as each of the means (**Paragraph 57**).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 4, 5, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shintai, in view of Pihl, et al (**US PG Publication 2003/0186707**). From now on, Pihl, et al, will be referred to as Pihl.

Regarding claims 4 and 14, Shintai teaches a wireless terminal as set forth in claims 1 and 11, respectively. Shintai fails to teach the identification data contains a key for encrypting the data and a key for decrypting the encrypted data. Pihl teaches the identification data contains a key for encrypting the data and a key for decrypting the encrypted data (**Paragraphs 38-39, Paragraph 44 and chart that follows**). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Shintai to include an encryption/decryption unit for the benefit of added security.

Regarding claims 5 and 15, Shintai teaches a wireless terminal as set forth in claims 4 and 14, respectively. Shintai fails to teach the key for encrypting the data and

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the key for decrypting the encrypted data are algorithms specific to the base device indicated by the identification data. Pihl teaches the key for encrypting the data and the key for decrypting the encrypted data are algorithms specific to the base device indicated by the identification data **(An algorithm may be used to determine whether base station location charges are applicable, Paragraphs 38-39, Paragraph 44 and chart that follows)**. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Shintai to include an ncryption/decryption unit for the benefit of added security.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**US PG Publication 2004/0082344** refers to a method for identification of base stations and for checking measurement values of an observed time difference between transmissions from base stations.

**US PG Publication 2004/0063428** refers to base station identification in a wireless telecommunications system.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK DONADO whose telephone number is (571) 270-5361. The examiner can normally be reached on Monday-Thursday, 8 am-5 pm and at the same time on alternate Fridays, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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supervisor, Rafael Perez-Gutierrez can be reached on 571-272-7915. The fax phone number for the organization where this application or proceeding is assigned is 571-270-6361.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-273-8300.

/Frank Donado/  
Art Unit 2617

/Rafael Pérez-Gutiérrez/

Supervisory Patent Examiner, Art Unit 2617